

Application Serial No. 09/543,310
Amendment E
Reply to Office Action of December 13, 2005

REMARKS/ARGUMENTS

This paper is being submitted in response to the Non-Final Office Action dated December 13, 2005, having a shortened statutory period set to expire March 13, 2006, wherein:

Claims 1-51 were previously pending; and

Claims 1-7, 9-15, 17-23, 25-31, 33-39 and 41-47 were rejected.

No claims have been added by this amendment; claims 49-51 have been canceled without prejudice or disclaimer of the subject matter recited therein; and claims 1, 9, 17, 25, 33, and 41 have been amended herein. Accordingly, claims 1-48 remain currently pending in the above-identified patent application. Applicant submits that no new matter has been added by this amendment and respectfully requests reconsideration of all pending claims in light of the amendments and remarks made herein.

Formal Matters

In the present Non-Final Office Action, the Examiner has incorrectly indicated that claims 1-7, 9-15, 17-23, 25-31, 33-39 and 41-47 were previously-pending in the above-identified application. Applicant's note that claim 1-51 were pending as of the most-recently submitted reply (Applicant's Amendment D, submitted via facsimile on September 23, 2005, hereinafter, "Amendment D") and that no other amendments have been submitted in the present application. Applicant further notes that the Examiner has failed to address the specific arguments presented in Amendment D, but merely added new rejections under 35 U.S.C. §112 and reiterated previously-presented rejections as will be more-specifically addressed below.

Claim Rejections under 35 U.S.C. § 112

In the present Non-Final Office Action, the Examiner rejected Applicant's claim 1 under 35 U.S.C. §112, paragraph 1, as failing to comply with the enablement requirement. More specifically, the Examiner indicated that Figure 2 of Applicant's specification did not sufficiently correspond to the language of Applicant's claim 1 as presented. While Applicant may be required to illustrate that which is claimed, there is no requirement that such an illustration is made within a specific drawing figure. Applicant directs the Examiner to Figure 3 as originally

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filed which depicts, *inter alia*, a wireless device web page request (Applicant's Figure 3, process block 310) and subsequent operations including, "Proxy Server Tailors Reduced Content", "Has User Requested Default Alternet [sic] Delivery Method", "Proxy Delivers Reduced Content", and "Proxy Delivers Full Content to Alternate System" (Applicant's Figure 3, process blocks 320, 330, 360, and 370). Applicant respectfully submits that Figure 3 is sufficient to enable one of ordinary skill in the relevant art to perform "sending a reduced-content page, corresponding to the first data page, from the first data processing system to the second data processing system" in response to "the request from the second data processing system" as required by Applicant's claim 1, without undue experimentation. Should the Examiner harbor any lingering doubts as to the adequacy of Applicant's disclosure, Applicant would be pleased to endeavor to provide an affidavit supporting the sufficiency of the present application under 35 U.S.C. § 112.

In the present Non-Final Office Action, the Examiner rejected Applicant's claim 1 under 35 U.S.C. § 112, paragraph 2, as failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More specifically, the Examiner indicated that the word "expensive" in claim 1 was not sufficiently specific for purposes of 35 U.S.C. § 112, paragraph 2, and that there was insufficient antecedent basis for this limitation of the claim. Applicant notes that the fact that a claim's language includes words of degree or relative terms that may not be precise does not automatically render a claim indefinite under 35 U.S.C. § 112 (*In re Oetiker*, 91 F. 2d 1267, 23 U.S.P.Q. 2d 1661, 1662 (Fed. Cir. 1991) (unpublished)). Rather, the determination to be made is whether one of ordinary skill in the art, in view of the prior art, would nevertheless be reasonably apprised of the scope of the invention (*Seattle Box Co. v. Industrial Crating and Packaging, Inc.*, 731 F. 2d 818, 221 U.S.P.Q. 568, 574 (Fed. Cir. 1984)). While Applicant respectfully submits that all claims as previously-submitted are sufficiently clear for purposes of 35 U.S.C. § 112, in the interest of expediting prosecution, Applicant has amended independent claims 1, 9, 17, 25, 33, and 41 to remove the recitation of a one connection which is "more expensive" than another and canceled claims 49-51 without prejudice or disclaimer of the subject matter recited therein. Accordingly, Applicant submits that the Examiner rejection is overcome and should be withdrawn.

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Claim Rejections under 35 U.S.C. § 103

In the present Non-Final Office Action, claims 1-7, 9-15, 17-23, 25-31, 33-39, and 41-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,430,624 issued to Jamtgaard et al., (hereinafter, "*Jamtgaard*") in view of United States Patent No. 6,615,131 issued to Rennard et al., (hereinafter, "*Rennard*") and claims 8, 16, 24, 32, 40, and 48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Jamtgaard* in view of *Rennard* and further in view of United States Patent No. 6,148,330 issued to Puri et al., (hereinafter, "*Puri*"). While not conceding that any of the Examiner's cited references qualify as prior art but in the interest of expediting prosecution, Applicant has elected to traverse the Examiner's rejections as follows. Applicant reserves the right, for example in a continuation application, to establish that one or more of the Examiner's cited references do not qualify as prior art with respect to the invention embodiments currently or subsequently claimed.

More specifically, with regard to the Examiner's rejection under 35 U.S.C. §103, the present Office Action appears to be a word-for-word duplicate of the prior Office Action having a mailing date of June 23, 2005. The Examiner has therefore failed to address or refute any of the arguments made by Applicant in Applicant's Amendment D. Applicants have attempted to reiterate and clarify the arguments made in Amendment D herein to preserve all issues for Appeal should the Examiner be unable to advance prosecution in any subsequent action.

Jamtgaard fails to teach "sending" a reduced-content page and first data page as claimed

Applicant notes that, in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (see MPEP §2143).

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In exemplary claim 1, Applicant recites 1) a first data processing system 2) a second data processing system 3) a third data processing system and 4) that in response to a request for a first data page received in the first data processing system from the second data processing system A) a reduced-content page, corresponding to the first data page is sent from the first data processing system to the second data processing system and B) the first data page is sent from the first data processing system to the third data processing system (emphasis supplied). Applicant's claim 1 further teaches that the third data processing system is used by a user of the second data processing system but is separate and distinct from the second data processing system. (Applicant's claim 1 as previously presented)

By contrast, *Jamtgaard* teaches a content delivery system which includes (see, e.g., *Jamtgaard*, Figs. 4 and 5) a translation server 12, a content provider 13, a web server, and an information appliance 15. According to *Jamtgaard*'s teaching, when a request to access a web page from a content provider 13 is made by an information appliance 15, the content provider 13 redirects any non-PC requests to translation server 12 so that the web page information can be translated (by translation server 12) into a data format appropriate for and recognizable by the destination information appliance 15. A content connection handler 40 within translation server 12 then mimics a standard HTML browser and receives content from content provider 13. Thereafter, according to *Jamtgaard*'s teaching, an appliance connection handler 44 within translation server 12 retrieves page information from content connection handler 40, translates received pages, and then operates as a web server to transmit translated page information to a requesting information device 15. (*Jamtgaard*, Column 6, Line 31 – Column 8, Line 24)

Applicant respectfully submits that, even if the individual components of translation server 12 are considered, *Jamtgaard* fails to teach that in response to a receipt, at a first data processing system, of a request for a first data page, a reduced-content page corresponding to the first data page is sent from the first data processing system to a second data processing system and the first data page is sent from the first data processing system to a third data processing system as claimed. Rather, content provider 13 receives a web page request and provides content to an emulated HTML browser of content connection handler 40 within translation server 12 but fails to provide translated page information (which is provided instead by appliance

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connection handler 44 of translation server 12) let alone a reduced-content page, corresponding to a requested first data page as claimed. Similarly, even if it is assumed *arguendo* to receive web page requests for forwarding to content provider 13, appliance connection handler 44 provides translated page information to a requesting information appliance 15, but does not similarly provide an originally requested web page.

The progression clearly taught by *Jamtgaard* is therefore of web page information from a content provider which receives a web page request to a translation server and thereafter of translated page information from the translation server to a requesting information appliance. Applicant submits that no other web page information is sent from the translation server to either the content provider or information appliance and further that no translated web page information is sent by the content provider at all.

Applicant further notes that any attempt to combine content provider 13 and appliance connection handler 44 into a single element which receives web page requests and provides translated page information and web page content would obviate any need for content connection handler 40 contrary to *Jamtgaard*'s teaching. Consequently, Applicant respectfully submits that no permissible combination or modification including the teaching of *Jamtgaard* may be construed as showing or suggesting "sending" a reduced-content page and first data page as claimed. Moreover, as neither *Rennard* nor *Puri* has been cited or indicated by the Examiner as teaching, showing, or suggesting "sending" a reduced-content page and corresponding first data page as claimed, Applicant submits that for at least those reasons previously stated herein no permissible combination of *Jamtgaard*, *Rennard*, and/or *Puri* may be construed as teaching showing, or suggesting such "sending" as recited by Applicant's claims.

For at least the foregoing reasons, Applicant respectfully submits that claim 1, as previously presented, is allowable in view of the Examiner's cited references. Applicant's claims 9, 17, 25, 33, and 41 each include one or more limitations or elements substantively similar to those described with respect to Applicant's claim 1 and are therefore allowable for at least the reasons stated with respect to that claim. All remaining claims depend directly or indirectly from Applicant's claims 1, 9, 17, 25, 33, or 41 and are therefore similarly allowable.


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CONCLUSION

In light of the amendments and remarks made herein, Applicant submits that all pending claims are allowable and earnestly solicits notice thereof.

No extension of time is believed to be necessary in conjunction with this paper. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time as well as any other fee necessary to further the prosecution of this application to **IBM CORPORATION DEPOSIT ACCOUNT No. 09-0447**.

Respectfully submitted,


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